



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,246	09/10/2003	H. Hoogland	294-79 DIV	3492
23869	7590	03/07/2006	EXAMINER	
HOFFMANN & BARON, LLP			TRUONG, THANH K	
6900 JERICHO TURNPIKE			ART UNIT	
SYOSSET, NY 11791			PAPER NUMBER	

3721

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,246

Applicant(s)

HOOGLAND ET AL.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-45 and 47-88 is/are rejected.
- 7) ☒ Claim(s) 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on December 16, 2005.
2. Applicant's cancellation of claims 1-39 is acknowledged.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 40-43, 50, 52, 55-58, 65, 67-71, 73-82, 85, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

Heiligers discloses a method for manufacturing a storage device (1) for plate-shaped data carriers (2), the storage device having a first cover and a second cover (3, 5) pivotally connected (at 6 with the intermediate part 4), and loading the plate-shaped data carrier in the storage device.

Heiligers discloses the claimed invention, but does not expressly disclose the positioning of the authentication means in the injection molding part.

Foulkes discloses the in-mold labeling technique in which a pre-formed polymeric label is incorporated into a polymeric article by molding the article in a mold containing

Art Unit: 3721

the label providing an attractive appearance article and the label is difficult to remove (column 1, lines 13-19).

Wolpert discloses that in-mold labeling is an effective authenticating means to prevent counterfeiting and to secure valuable merchandise (column 1, lines 17-40).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers' method by incorporating the in-mold labeling as taught by Foulkes and Wolpert providing an attractive article with authenticating means being injection molding within the part that is difficult to remove and preventing counterfeiting of the article.

Heiligers, Foulkes and Wolpert further disclose: the storage device is injection molded in one piece (Heiligers – figure 1); the authentication means (such as bar code 16, 46b – Wolpert, figures 4A and 8); providing a printing and placing the printing (such as bar code) in the molding part and form an integral part of the cover; the printing is introduced into the mold on a carrier (Wolpert, figure 4A); the authentication means is a magnetic means which is positioned on a carrier in the mold, and injecting plastic around the magnetic means, such that the carrier is enclosed therein; a fixing means or resilient fingers (17) within the storage device for fixing the plate shaped data carrier in the storage device (Heiligers, figure 2a), and the data carrier is a CD (2); and the hinge (6) forming an integrated one piece hinge between the first and second cover.

Regarding to claim 79, the examiner takes Official Notice that offering the data carrier house in the storage device to consumers for sale is obvious and well known. As Wolpert has clearly pointed out that the function of the authentication means is to

Art Unit: 3721

prevent counterfeiting of the product and also to secure the "valuable merchandise" (column 1, lines 17-19), and the main purpose of the manufacturing industry is to produce products for sale in the markets for profit. Therefore, it would have been obvious to state that Heiligers, Foulkes and Wolpert further comprising offering the carrier housed in the storage device to consumer for sale.

5. Claims 53, 54 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

As discussed above in paragraph 4 of this office action, Heiligers, Foulkes and Wolpert discloses the claimed invention, but do not expressly disclose that the carrier having printing on two sides. The examiner takes Official Notice that it would have been obvious to provide a carrier having printing on both side so the printing (such as bar code) can be seen on both side without being turn around.

Regarding claim 54, the carrier being at least partially transparent is inherent, because in order to read the bar code, the storage device needs to be at least partially transparent.

6. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

As discussed above in paragraph 4 of this office action, Heiligers, Foulkes and Wolpert discloses the claimed invention, but do not expressly disclose the melting index of at least 30 and 50. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have performed the injection molding of Heiligers using the melt index as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 44, 45, 47-49, 59-62 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948), and further in view of Hanamoto et al. (4,639,341).

As discussed above in paragraph 4 of this office action, Heiligers, Foulkes and Wolpert discloses the claimed invention, but do not expressly disclose the placing of the carrier adjacent a wall of the mold and inject the plastic to contact the carrier and the mold wall.

Hanamoto discloses a method in which the carrier (32) with the printing indicia (10) is placed adjacent a wall of the mold and the plastic is injected to contact the carrier and the mold wall (figures 1-7). Hanamoto provides an effective method to molding articles by injection molding while simultaneously imprinting or transferring patterns on a continuous sheet on or to the molded articles (column 1, lines 14-17).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers' method by

Art Unit: 3721

incorporating the molding articles with printing pattern as taught by Hanamoto providing an effective molding process that produce printing pattern on the injection molding article.

Hanamoto further discloses: the stretching of the carrier before placing the carrier in the mold so that the carrier is pulled taut (column 3, lines 52-62); the carrier fuses with the plastic; wherein the printing is designed as a transfer (column 1, lines 15-16).

8. Claims 51, 72 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986), Wolpert et al. (6,255,948), and further in view of Walters (5,815,292) and Palmer et al. (5,189,531).

As discussed above in paragraph 4 of this office action, Heiligers, Foulkes and Wolpert disclose the claimed invention, but do not expressly disclose that the printing further comprises providing a holographic printing.

Walters discloses that holograms are commonly used as authenticating devices because it provide a three-dimensional image, and thus it is difficult to reproduce (column 1, lines 15-17).

Palmer discloses that holograms are formed in moldable materials by utilizing injection molding can be applied to digital compact audio discs or video discs (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers, Foulkes and Wolpert method to include the hologram image as taught by Walters and Palmer to provide an authenticating devices that is difficult to reproduce.

9. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

As discussed above in paragraph 4 of this office action, the modified Heiligers, by Foulkes and Wolpert discloses the claimed invention, but do not expressly disclose the step of positioning a printer head adjacent a surface of an injection mold.

Wolpert discloses that the graphic indicia can be printed as line work or as halftone (Wolpert – column 5, lines 40-43), and the printing can be accomplished by using “multiple print stations” (Wolpert – column 7, lines 31-33). Therefore, the examiner takes Official Notice that it would have been obvious to one having ordinary skill in the art, at the time applicant’s invention was made, to have included the printer head adjacent to the surface of the injection mold for a better controlling of the printing on the mold surface and therefore a better printing quality.

Allowable Subject Matter

10. Claim 46 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed December 16, 2005 have been fully considered but they are not persuasive.

Art Unit: 3721

12. In response to the Applicant's argument that the 103 rejections are based on "impermissible hindsight" and "there is no suggestion in the prior art references for combining in-mold labeling with CD or DVD case manufacturing", the examiner respectfully disagrees.

It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Helligers discloses a method for manufacturing a storage device as recited in the claimed invention; Foulkes discloses the in-mold labeling technique in which a pre-formed polymeric label is incorporated into a polymeric article by molding the article in a mold containing the label providing an attractive appearance article and the label is difficult to remove (column 1, lines 13-19); and Wolpert discloses that in-mold labeling is an

Art Unit: 3721

effective authenticating means to prevent counterfeiting and to secure valuable merchandise (column 1, lines 17-40). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Helligers storage device by incorporating the in-mold labeling technique as taught by Foulkes and demonstrated by Wolpert that the in-mold labeling is an effective authenticating means to protect the storage device from counterfeiting and thefts (at the sale location).

13. In response to Applicant's argument that in Wolpert patent "there is absolutely no disclosure in this reference of providing in-mold labeling data specific to a CD or DVD", Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements CD or DVD are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1064.

Furthermore, Wolpert and Foulkes are relied upon for the teaching of the in-mold labeling as a security means that is disposed on storage device such as "a carrier substrate" (Wolpert – abstract).

14. In response to the Applicant's argument that "in Wolpert, the authentication label is physically attached to the actual product itself, as opposed to the box or case in which the product is to be stored, as set forth in the claimed invention ... the Wolpert patent

actually teaches away from attaching such label to the box, as defined in the claims of the present invention”, the examiner respectfully disagrees.

Wolpert (column 4, lines 58-65) discloses that:

“The security device 10 can also be used in labels, tags or packaging material ... the magnetic/metallic security device 10 authenticates and/or is encoded with data relating to the articles to which the labels or packaging material is attached” (emphases added).

The examiner construes that Wolpert teaching is applicable to the packaging material such as the storage device for plate-shaped data carriers as claimed in the present application.

15. In response to the Applicant’s argument (regarding claim 79) that: “the Examiner incorrectly equates the box containing the data carrier with the valuable merchandise ... Claim 79 patentably distinguishes over the prior art for this additional reason”, the Examiner respectfully disagrees.

The Applicant perhaps incorrectly interpreted the examiner’s rejection of claim 79. Claim 79 recites: “A method according to claim 78 further comprising offering said data carrier housed in said storage device to consumers for sale” (emphasis added), and the examiner takes Official Notice that it is old and well known in the art to offer the data carrier housed in a storage device (or anything in that matter) to consumer for sale. Offering merchandise to consumer for sale is neither new nor novel.

Accordingly, since the Applicant fails to challenge the Official Notice taken by the examiner in the previous office action (July 14, 2005), the well known in the art statement in the office action of June 12, 2005 (regarding to claim 79) is taken to be admitted prior art.

Art Unit: 3721

16. In response to the Applicant's argument (regarding claims 53, 54 and 66) that:

"With respect to dependent Claims 53, 54 and 66, although the Examiner states that it would have been obvious to provide printing on both sides of a label, this has not been shown nor rendered obvious. Indeed, such CD or DVD cases are sold in a closed position, which would make any person skilled in the art believe that the printing on the inside would be less important. Moreover, DVD-boxes are normally made in opaque plastic, such as black plastic, as are most trays of CD-boxes. Therefore, it is not at all obvious that a person skilled in the art would think of providing printing on both sides of a label" (emphases added),

the examiner respectfully disagrees. The arguments (underline) presented by the Applicant are mere speculations, and thus have no merits. The examiner takes Official Notice that it is old and well known in the art to print label (such as the bar code) on both sides of the storage carrier so that the labels can be seen on either sides without being turned around.

Accordingly, since the Applicant fails to challenge the Official Notice taken by the examiner in the previous office action (July 14, 2005), the well known in the art statement in the office action of June 12, 2005 (regarding to claims 53 and 66) is taken to be admitted prior art.

17. In response to the Applicant's argument (regarding claim 54) that:

"With further respect to dependent Claim 54, the Examiner is incorrect in his application of the Foulke patent in that the label disclosed therein is provided on the outside of the product, which would allow the printing to be seen without the necessity of the product being transparent",

the examiner respectfully disagrees. The examiner maintains that the transparency of the carrier (the storage device) is inherent, because in order to read the bar code, the storage device need to be at least partially transparent.

In response to the Applicant's argument (regarding claims 63 and 64), the examiner maintains that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have performed the injection molding of Heiligers using the melt index as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

18. In response to the Applicant's argument (regarding claims 51, 72 and 86) that:

"the Examiner argues that the use of holograms as authentication means would be obvious from Walters and/or Palmer. However, while the Walters and Palmer patents may generally disclose holograms, there is absolutely no teaching or suggestion in these references of using such holograms in a device or method according to the present invention. For explained above, a person skilled in the art would not be led to such device, and, therefore, would certainly not be led to such device using holograms for authentication of a CD-box or a DVD-box. Also, while it may be known in the art to authenticate products with, for example, a software number, such authentication means are not injection molded, nor in-mold labeled but are provided by means of a sticker or the like. Therefore, the advantages of the present invention, as set forth in dependent Claims 51, 72 and 86 have not heretofore been recognized, and, accordingly, it is respectfully submitted that these claims are patentable in their own right",

the examiner respectfully disagrees. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The examiner maintain that: Walters discloses that holograms are commonly used as authenticating devices because it provides a three-dimensional image, and thus it is difficult to reproduce (column 1, lines 15-17).

Palmer discloses that holograms are formed in moldable materials by utilizing injection molding can be applied to digital compact audio discs or video discs (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers, Foulkes and Wolpert method to include the hologram image as taught by Walters and Palmer to provide an authenticating devices that is difficult to reproduce.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

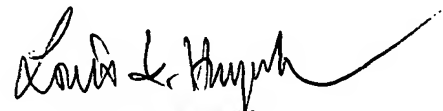
Art Unit: 3721

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tkf
February 14, 2006.


LOUIS K. HUYNH
PRIMARY EXAMINER

DRAWING APPROVED 11/25 3/12/06



"Replacement Sheet"

1/7

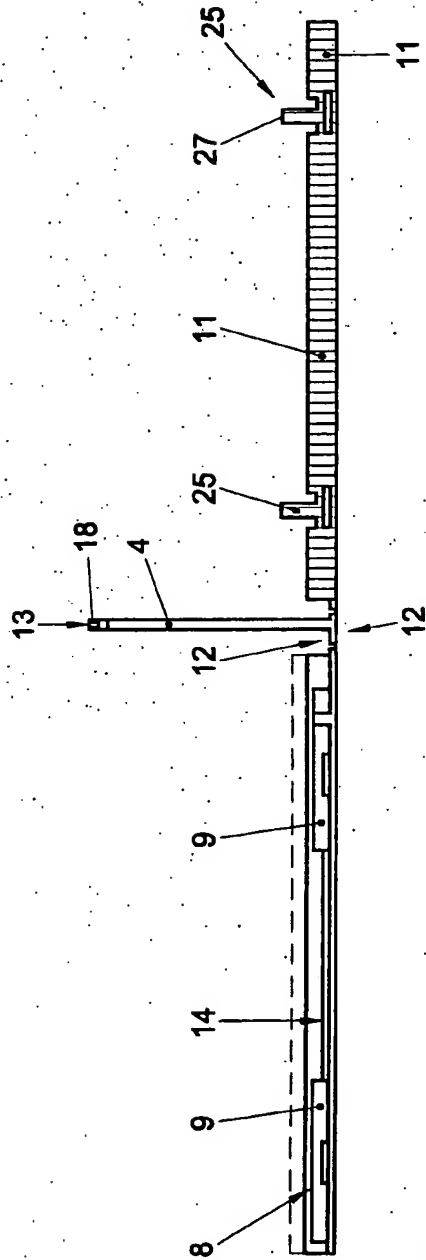


Fig. 1A

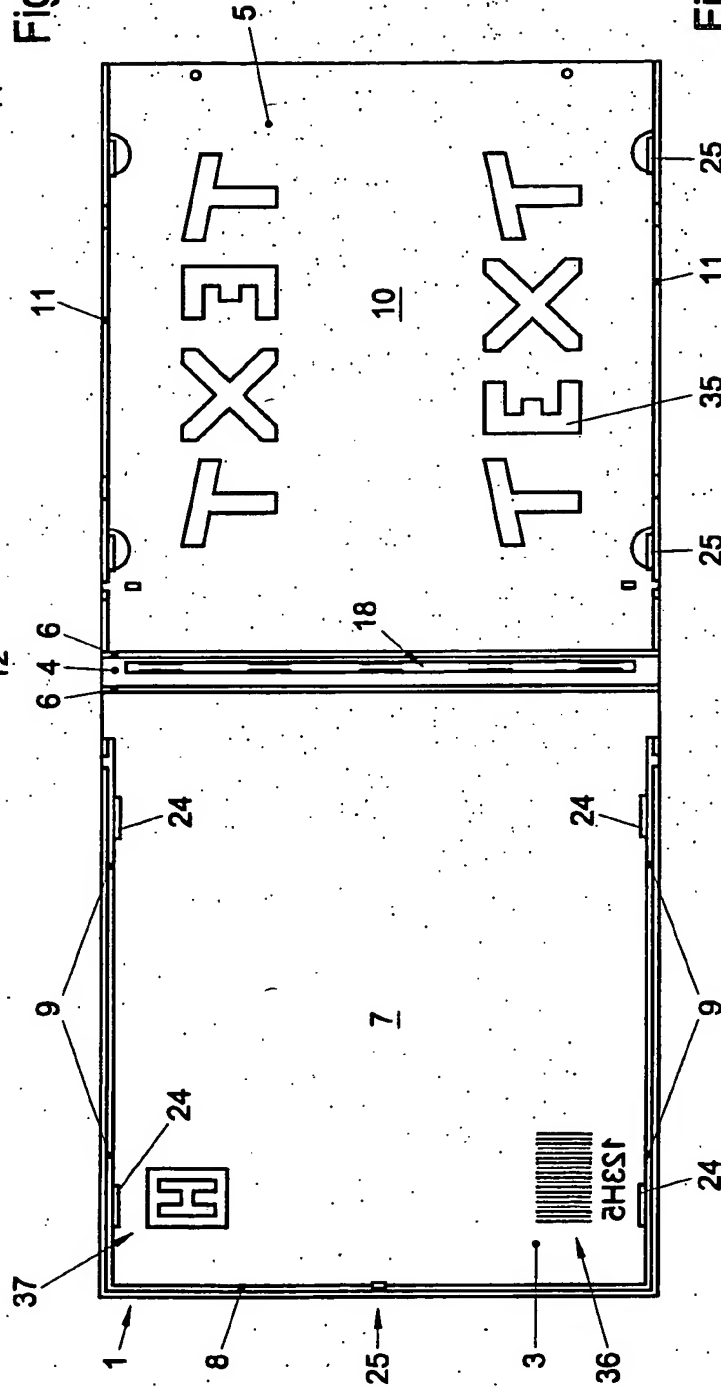


Fig. 1

A circular black ink stamp from the Office of Intellectual Property (OIPE). The text "OIPE" is at the top, "IAPRS" is at the top right, "DEC 16 2005" is in the center, and "PATENT & TRADEMARK OFFICE" is at the bottom.

217

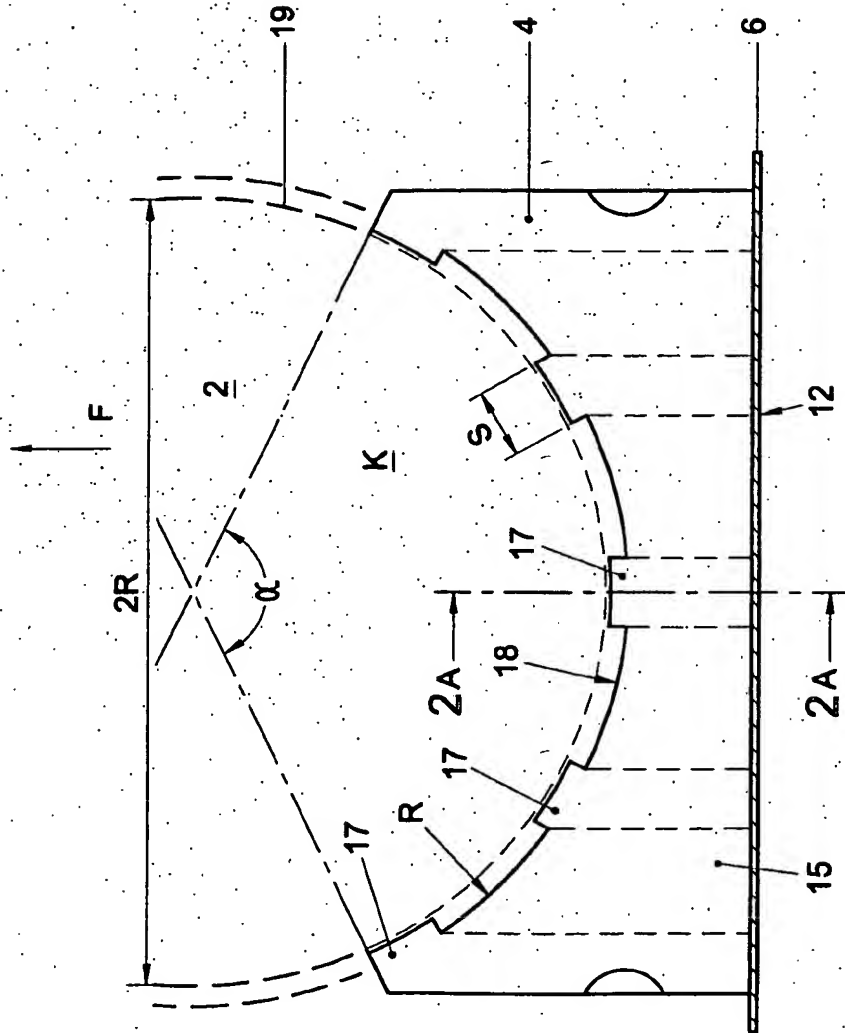


FIG. 2